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MCGINN & GIBB, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

EXAMINER	
ROSEN, NICHOLAS D	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/742,362	TESHIMA, ATSUSHI	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 1, 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-7,9,10 and 14-30* is/are rejected.

7)☒ Claim(s) *3,4,8 and 11-13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 June 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-30 have been examined.

Official Notice

Applicant has not expressly and in correct format traversed Examiner's takings of official notice, but as certain statements in Applicant's Remarks can reasonably be viewed as challenging some of Examiner's takings of official notice, Examiner makes of record documents which support those takings of official notice:

In rejecting claim 10, Examiner took official notice that it is well known to inspect goods. Hickey ("Going Once, Going Twice") discloses inspection of goods offered for sale on an electronic commerce site (in particular, paragraphs beginning "Unlike TradeOut.com" and "Items are usually listed"). Taj ("ISN Takes Chinese Home Shopping a Step Forward") discloses inspection of goods by customers to whom they are shipped. Wood ("Steel Termed Essential Aircraft Component") discloses inspecting bars and billets prior to shipment (paragraph beginning "Tight chemistry controls"). Lection et al. (U.S. Patent 5,983,003) disclose inspecting items in an electronic mall (column 2, lines 29-35).

In rejecting claim 22, Examiner took official notice that it is well known to lease equipment, and thus to manage information about leasing. The anonymous article, "Tools of the Trade" discloses a package for lease inventory management. Keifer ("Service Vendor Alliance Will Simplify Sourcing and Service of Enterprise-Wide Computer Systems") discloses a lessor with expertise in leasing computers (paragraph

beginning "GE Capital Computer Leasing"). Aslett ("Please Re-Lease Me") discloses leasing IT equipment, and managing information through a database system, described as a necessity for those having a large inventory (paragraph beginning "It's a similar story from Peregrine Systems"). The anonymous article "Standard & Poor's Approves First Capital International, Inc. For Listing," discloses EIP Leasing-Estonia as a leasing company involved in equipment leasing.

In rejecting claim 23, Examiner took official notice that catalog printing apparatus is well known. Bezos (U.S. Patent 5,727,163) discloses mailing printed catalogs to Internet customers, implying the existence of catalog printing apparatus (column 8, lines 18-33). Chiasson (U.S. Patent Application Publication 2002/0002513) discloses can print portions of an electronic catalog at his own computer (paragraphs 76 and 79).

In rejecting claim 24, Examiner took official notice that searching apparatus in virtual malls is well known. Suzuki et al. (U.S. Patent 5,946,665) disclose searching apparatus for searching for goods in a cyber-mall (column 1, line 42, through column 2, line 6; column 3, lines 4-18 and 26-32; column 4, line 66, through column 5, line 14; column 6, lines 1-14; column 6, line 55, through column 7, line 1; Figure 1). Issa (U.S. Patent Application Publication 2003/0093355) discloses a virtual mall for searching the best price for a product (paragraph 21). Yagasaki (U.S. Patent 6,125,353) discloses a mall server with a search function (Abstract; Figure 1; column 2, lines 60-65; column 4, lines 12-24).

In rejecting claim 25, Examiner took official notice that it is well known to use recording media storing programs to instruct computers to carry out methods. Suzuki et

al. (U.S. Patent 5,946,665) claim such a program stored on a computer-readable medium (claim 7, column 13 and 14 in the Suzuki patent), for an on-line shopping system. Lection et al. (U.S. Patent 5,983,003) disclose programming for their electronic shopping invention, again stored on media such as a diskette, hard drive, or CD-ROM (column 4, line 63, through column 5, line 12).

Specification

Examiner wishes to call Applicant's attention to the fact that in various lines, the words of the specification are quite closely spaced, which could pose a problem if the application is published as a patent.

Claim Objections

Claims 1-13 are objected to because of the following informalities: In line 8 of claim 1, as amended, "form said seller" should be "from said seller". Appropriate correction is required.

Claim 5 is objected to because of the following informalities: The phrase "seller's setting said terminal base at a plurality of real terminal bases" is unclear, and should preferably be "seller's setting said terminal base at any of a plurality of real terminal bases", or "seller's setting said terminal base at at least one of a plurality of real terminal bases", or some other appropriate phrase. Appropriate correction is required.

Claims 15-24 are objected to because of the following informalities: In the fourth line of claim 15, "forms" should be "forming". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, 6, 7, 9, 10, 26, 27, and 28

Claims 1, 2, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," in view of the anonymous article, "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," hereinafter "Netcentives," the anonymous article, "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," hereinafter "Microsoft Plaza," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?"). As per claim 1, "Electronic Transfer Associates" discloses presenting virtual goods information, corresponding to sellers' real goods, in a virtual shopping mall, which would not be possible without receiving and registering virtual goods information from the sellers; intermediating business between said seller and a buyer on said virtual shopping mall by presenting said virtual goods information to a buyer (first four paragraphs); and establishing trading between said buyer and said seller, which achieves business on said virtual shopping mall (ibid.). "Electronic Transfer Associates" does not disclose setting a delivery path for delivering said real goods from said seller to said buyer in

accordance with said buyer's selection of a terminal base, but "Netcentives" teaches a package delivery program using PackageNet (fifth paragraph), Galler expressly teaches that PackageNet has applications for pick-up as well as shipping and return (see section regarding "Depot Delivery"), and "Microsoft Plaza" teaches that buyers select their nearest PackageNet store locations (second paragraph). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to set a delivery path for delivering said real goods from said seller to said buyer in accordance with said buyer's selection of a terminal base, for the obvious advantage of shipping to locations convenient for the buyers.

As per claim 2, "Electronic Transfer Associates" discloses that said business is intermediated by presenting an image to the buyer (third paragraph). "Electronic Transfer Associates" does not expressly disclose that registering said virtual goods information includes capturing an image of the real goods as a part of virtual goods information, but does disclose providing a full description including a picture of the product, which implies having captured an image of the real goods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have registering said virtual goods information include capturing an image of the real goods as a part of virtual goods information, for the obvious advantage of enabling the picture of the product to be presented.

As per claim 6, "Electronic Transfer Associates," "Electronic Transfer Associates" does not disclose instructing a physical distribution system, which includes a plurality of real terminal bases, to deliver said real goods, but "Microsoft Plaza" teaches a physical

distribution system, which includes a plurality of real terminal bases (second paragraph, "400 supermarkets that off PackageNet"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to instruct a physical distribution system, which included a plurality of real terminal bases, to deliver said real goods, for the obvious advantage of delivering the goods to locations convenient to buyers.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler as applied to claim 2 above, and further in view of www.PackageNet.com as of November 29, 1999. "Electronic Transfer Associates" does not disclose said seller's setting said terminal base at a plurality of real terminal bases to bring in said real goods, but the PackageNet web site teaches the seller bringing a package to be shipped to one of the plurality of real terminal bases (page titled "How To Ship Packages With PackageNet," specifically paragraph 3). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the trading include the seller's setting said terminal base at one of said plurality of real terminal bases to bring in said real goods, for the obvious advantage of enabling said real goods to be conveniently shipped to the buyer.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler as applied to claim 2 above, and further in view of Shkedy (U.S. Patent 6,260,024). "Electronic Transfer Associates" does not disclose that the business is intermediated by presenting

said virtual goods information to said buyer so as to secure anonymity of said seller, but Shkedy teaches conducting electronic commerce wherein an intermediary secures the anonymity of sellers (column 8, lines 27-39). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the business be intermediated by presenting said virtual goods information to said buyer so as to secure anonymity of said seller, for the stated advantage of enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler as applied to claim 2 above, and further in view of official notice. "Electronic Transfer Associates" does not disclose updating a seller's database when trading is established, wherein the computer system stores a trade history for each seller in the seller's database, and setting the fee for the virtual shopping mall lower for those sellers whose amount of past trades stored in said seller's database is large. However, official notice is taken that it is well known to give volume discounts, and to maintain databases of information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to set the fee for the virtual shopping mall lower for those sellers whose amount of past trades stored in said seller's database is large, for the obvious advantage of encouraging sellers to do business through the virtual shopping mall.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza" and Galler as applied to claim 2 above, and further in view of official notice. "Electronic Transfer Associates" does not disclose inspecting goods. However, official notice is taken that it is well known to inspect goods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to inspect the goods, for such obvious advantages as assuring that the goods a business is shipping are what was ordered, and of good quality, so as to avoid complaints, lawsuits, and the need to replace defective goods, and to maintain a reputation for quality; and assuring that the goods which one has received are what was ordered, and of good quality, so as to decide whether to pay for them, and whether to request a refund or a replacement. (Claim 10 does not specify who does the inspecting.)

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler as applied to claim 1 above, and further in view of Scisco ("Tend the Store for World Wide Orders"). As per claim 26, "Electronic Transfer Associates" does not disclose registering a seller for selling virtual goods, but Scisco teaches registering a seller for selling virtual goods; and reserving a space for presenting said virtual goods upon said registration before registering said virtual goods information (paragraphs beginning "But a shop on the Internet" and "Price considerations led us"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the method comprise registering a seller for selling virtual

goods, and reserving a space for presenting said virtual goods upon said registration before registering said virtual goods information, for the obvious advantage of enabling a seller to make arrangements to sell his goods without requiring him to register his virtual goods information (he may not know just what goods he has available, or how his selection of available goods may change over time, with some items being sold, and more being made or acquired).

As per claim 27, Scisco teaches providing a plurality of units, each representing one of said virtual goods, each representing one of the virtual goods, into the space (paragraphs beginning "We began working with Live Store by entering descriptions" and "Seeing how simple the other changes had been"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the method comprise providing a plurality of units, each representing one of said virtual goods, each representing one of the virtual goods, into the space, for the stated advantage of enabling the seller to present descriptions and/or images of his goods to potential customers.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler as applied to claim 1 above, and further in view of Hess et al. (U.S. Patent 6,058,417). "Electronic Transfer Associates" does not disclose that the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop, but Hess teaches a virtual shopping mall operated by the computer system, where sellers register goods information, etc., devoid of a seller opening a virtual shop (se especially column 1, lines

12-36; and column 6, line 57, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall be operated by the computer system devoid of a seller opening a virtual shop, for the obvious advantage of enabling sellers to offer items for sale without having to set up their own virtual shops, and for the obvious advantage of enabling buyers to conveniently search the items offered by multiple sellers without having to leave one virtual shop and enter another, both features of the eBay system taught by Hess.

Claims 14-24 and 29

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scisco ("Tend the Store for World Wide Orders") in view of the anonymous article, "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," hereinafter "Netcentives," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?"). Scisco discloses a virtual shopping mall system, which is established by using a computer system, comprising: a commercial goods managing database, which is provided to a seller and registers virtual goods information corresponding to real goods of said seller (four paragraphs beginning from "Because Clayton isn't as comfortable"; also "Step by Step" section at the end of the article, especially step 2; the database being inherent). Scisco does not disclose a delivery setting section, but "Netcentives" teaches using the package delivery program PackageNet (fourth paragraph), which involves setting a delivery path for real goods from said seller to said buyer when a trade has been established between said seller

and said buyer. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a delivery setting section, which achieves a trade on said virtual shopping mall by setting a delivery path for said real goods, from said seller to a buyer, when a trade has been established between said seller and said buyer who is presented with said virtual goods information in said commercial goods managing database, for the obvious advantage of shipping to locations convenient for the buyers.

Claims 15, 16, 17, 18, 19, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scisco, "Netcentives," and Galler as applied to claim 14 above, and further in view of www.PackageNet.com as of November 29, 1999, and Knowles et al. (U.S. Patent 5,869,819). As per claim 15, Scisco does not disclose that a plurality of terminal base units, each of which is installed at a real terminal base, form a physical distribution system, but the PackageNet website teaches a collection of terminal bases that form a physical distribution system, and Knowles teaches terminal base units at each of a plurality of real terminal bases (Abstract), connecting to the Internet. Scisco discloses an Internet shopping mall. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall system comprise a plurality of terminal base units, each installed at a real terminal base, that form a physical distribution system, each said terminal base unit connecting and communicating with a virtual shopping mall operations apparatus that manages said commercial goods managing apparatus, for the stated advantage of tracking packages being shipped.

As per claim 16, Scisco discloses a shop managing database, which sets up a virtual shop for selling goods for each of the sellers on said computer system; and a section for processing an owner registration procedure for sellers who want to open a virtual shop and be the owner thereof (first eleven paragraphs; final "Step by Step" section).

As per claim 17, Scisco does not disclose that each terminal base unit functions as a place for a seller to bring real goods and a buyer to receive said real goods, but the PackageNet web site teaches the seller bringing a package to be shipped to one of the plurality of real terminal bases (page titled "How To Ship Packages With PackageNet," specifically paragraph 3), and Galler teaches a buyer receiving goods in the PackageNet system (see paragraphs regarding "Depot Delivery"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for said terminal base to function as a place for a seller to bring real goods and a buyer to receive said real goods, through communication of information with said virtual shopping mall operations apparatus, for the obvious advantage of providing for goods to be conveniently shipped from the seller to the buyer.

As per claim 18, Scisco discloses generating virtual goods information that corresponds to real goods of a seller who is an owner of a virtual shop (four paragraphs beginning from "Because Clayton isn't as comfortable").

As per claim 19, Scisco discloses a media equipment device, which reads image data of real goods from a recording medium (two paragraphs following "Show, as Well as Tell").

As per claim 20, Scisco discloses an image capturing unit, which captures an image of real goods that are brought to a terminal by the seller (two paragraphs following "Show, as Well as Tell").

As per claim 21, Scisco disclose that the section for generating virtual goods information comprises a picture reading unit, which obtains image data of the real goods from a picture of the real goods brought in to the terminal base by the seller (two paragraphs following "Show, as Well as Tell").

Claims 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scisco, "Netcentives," Galler, www.PackageNet.com, and Knowles as applied to claim 15 above, and further in view of official notice. As per claim 22, Scisco does not disclose that the virtual shopping mall system comprises a section for managing, which manages information about leasing to a seller, or an owner of a virtual shop, an image capturing unit, which is used for generating virtual goods information that corresponds to real goods. However, official notice is taken that it is well known to lease equipment, and thus to manage information about leasing. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall system comprise a section for managing, which manages information about leasing to a seller, or an owner of a virtual shop, an image capturing unit, which is used for generating virtual goods information

that corresponds to real goods, for the obvious advantages of profiting from rental fees for such image capture units, and doing more business, with consequent increased profits, from the increased display of product images, since not every potential seller would, like Scisco and his brother, already have appropriate image capture apparatus.

As per claim 23, Scisco does not disclose a catalog printing apparatus, which prints out a catalog of virtual goods information, but official notice is taken that catalog printing apparatus is well known. (Many merchants print catalogs; furthermore, many PC's have printers which can be used to print on-line catalogs, or parts thereof, if the PC user chooses to do so.) Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the shopping mall system further comprise a catalog printing apparatus, for the obvious advantage of making printed catalogs available to potential buyers without Internet access, or without Internet access at the time they wish to study and order from a catalog.

As per claim 24, Scisco does not disclose a section for searching, which searches virtual goods information managed by a virtual shopping mall operations apparatus, but official notice is taken that searching apparatus in virtual malls is well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall system comprise a section for searching, for the obvious advantage of enabling potential buyers to readily find products of interest to them.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Scisco, "Netcentives," and Galler as applied to claim 14 above, and further in view of Hess et al: (U.S. Patent 6,058,417). Scisco does not disclose that the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop, but Hess teaches a virtual shopping mall operated by the computer system, where sellers register goods information, etc., devoid of a seller opening a virtual shop (se especially column 1, lines 12-36; and column 6, line 57, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall be operated by the computer system devoid of a seller opening a virtual shop, for the obvious advantage of enabling sellers to offer items for sale without having to set up their own virtual shops, and for the obvious advantage of enabling buyers to conveniently search the items offered by multiple sellers without having to leave one virtual shop and enter another, both features of the eBay system taught by Hess.

Claims 25 and 30

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the anonymous article "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," in view of Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") and official notice. "Electronic Transfer Associates" discloses presenting virtual goods information, corresponding to sellers' real goods, in a virtual shopping mall, which would not be possible without receiving and registering virtual goods

information from the sellers; and intermediating business between said seller and a buyer on said virtual shopping mall by presenting said virtual goods information to a buyer (first four paragraphs). This constitutes achieving a trade on said virtual shopping mall, but "Electronic Transfer Associates" does not disclose achieving a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer; however, Galler teaches a package delivery program using PackageNet (see paragraphs regarding "Depot Delivery"). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to achieve a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer, for the obvious advantage of making the goods conveniently available to the buyer.

"Electronic Transfer Associates" does not disclose a recording medium which stores a program that can be read by a computer, wherein the program is a program to operate a virtual shopping mall, the program comprising instructions for performing the method steps, but official notice is taken that it is well known to use recording media storing programs to instruct computers to carry out methods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to use such a recording medium storing a program, for the obvious advantage of saving the cost and trouble of hiring human beings to perform the steps of the method manually.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over "Electronic Transfer Associates," Galler, and official notice as applied to claim 25 above,

and further in view of Hess et al. (U.S. Patent 6,058,417). "Electronic Transfer Associates" does not disclose that the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop, but Hess teaches a virtual shopping mall operated by the computer system, where sellers register goods information, etc., devoid of a seller opening a virtual shop (se especially column 1, lines 12-36; and column 6, line 57, through column 7, line 40). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the virtual shopping mall be operated by the computer system devoid of a seller opening a virtual shop, for the obvious advantage of enabling sellers to offer items for sale without having to set up their own virtual shops, and for the obvious advantage of enabling buyers to conveniently search the items offered by multiple sellers without having to leave one virtual shop and enter another, both features of the eBay system taught by Hess.

Allowable Subject Matter

Claims 3 and 4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," discloses a method for operating a virtual shopping mall, including

some of the limitations of claims 1 and 2, while other limitations of claims 1 and 2 are taught by "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," hereinafter "Netcentives," "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," hereinafter "Microsoft Plaza," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?"), as set forth above. The closest prior art of record for the additional limitations of claim 3 is Scisco ("Tend the Store for World Wide Orders"); Kenney (U.S. Patent 6,026,376) and Kondoh et al. (U.S. Patent Application Publication 2001/0056377) are also relevant. Scisco teaches a seller requesting to modify his virtual goods information, and teaches the use (uploading) of images, but does not quite teach presenting each of the images already displayed in virtual goods information of a plurality of registered real goods to the seller when the seller requests to modify said virtual goods information, nor does any other prior art of record.

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," discloses a method for operating a virtual shopping mall, including some of the limitations of claims 1 and 2, while other limitations of claims 1 and 2 are taught by "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic

Commerce," hereinafter "Netcentives," "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," hereinafter "Microsoft Plaza," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") as set forth above. There is also prior art for charging sellers fees to display their goods information on a virtual shopping mall, and prior art for the goods information being divided into categories. However, neither "Electronic Transfer Associates" nor any other prior art of record discloses, teaches, or reasonably suggests setting the maximum value of the number of categories of said virtual goods which can be displayed on the virtual shopping mall according to the fee charged to the seller.

Claims 11 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," discloses a method for operating a virtual shopping mall, including some of the limitations of claims 1 and 2, while other limitations of claims 1, 2, and 10 are taught by "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," hereinafter "Netcentives," "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," hereinafter "Microsoft Plaza," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?"), or are well known in the art, as set forth above. However, neither

"Electronic Transfer Associates" nor any other prior art of record discloses, teaches, or reasonably suggests giving a penalty based on a predetermined penalty rule on said virtual shopping mall against said seller if said seller requests to register inappropriate virtual goods information.

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc.," hereinafter "Electronic Transfer Associates," discloses a method for operating a virtual shopping mall, including some of the limitations of claims 1 and 2, while other limitations of claims 1 and 2 are taught by "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," hereinafter "Netcentives," "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," hereinafter "Microsoft Plaza," and Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") as set forth above. However, neither "Electronic Transfer Associates" nor any other prior art of record discloses, teaches, or reasonably suggests forming a blacklist comprising a list of buyers who do not arrive to receive real goods they have ordered. It is known to blacklist people who do not meet their obligations, e.g., do not pay their bills, or do not pay for goods they have ordered, but that is not the same as blacklisting buyers who do not arrive to receive real goods they have ordered.

Response to Arguments

Applicant's arguments filed June 1, 2004, have been fully considered but they are not persuasive. Applicant argues that his invention (e.g., as defined by claim 1) is for a method of operating a virtual shopping mall by using a computer system, distinct from conventional virtual shopping mall systems that require a seller to create a website by himself/herself in order to open a virtual shop. Examiner responds that claim 1 does not define this distinction, and could read on a "conventional virtual shopping mall" where the seller has to create a website himself, the "virtual goods information" being registered in consequence of the seller uploading it to his virtual shop. New claims 28-30, which do specify such a distinction over the "conventional virtual shopping mall," are rejected in view of Hess (describing eBay, a virtual shopping mall of a type where sellers do not have to create their own virtual stores).

Further in regard to claim 1, Applicant argues that there is a lack of motivation or suggestion in the references to urge the combination, to which Examiner replies that the "Microsoft Plaza" reference in fact teaches the requisite motivation of customer convenience in selecting from a large number of pick-up/return locations.

Applicant also submits that the large number of references relied upon suggests that Applicant's claimed invention is non-obvious. In response to Applicant's argument that Examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Furthermore, the "Netcentives," "Microsoft Plaza," and

Galler references are not three different and unrelated systems combined to reconstruct Applicant's claimed invention, but three articles about the PackageNet system, making Applicant's complaint about the allegedly large number of references weaker than it might otherwise be.

In response to applicant's argument that Galler is directed to a product delivery service, and does not mention a virtual shopping mall, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Galler could be considered closely related to applicant's field of endeavor, or at least reasonably pertinent to the particular problem with which the applicant was concerned, namely delivery of goods ordered through e-commerce, even if Galler were not a description of PackageNet. However, since Galler is concerned specifically with PackageNet, and the "Microsoft Plaza" article describes PackageNet's involvement with a virtual shopping mall, Galler cannot reasonably be excluded as irrelevant.

Regarding claims 9 and 10, Applicant argues that Examiner has inappropriately taken Official Notice, and writes, "Specifically, the Examiner cannot take Official Notice of a system for inspecting goods as well as a system for providing volume discounts in a virtual shopping mall." Applicant does not explain the alleged reason why Examiner cannot do this, and there is no obvious reason why inspecting goods is incompatible

with providing volume discounts. Further, Examiner has provided references to support his taking of Official Notice that inspecting goods is well known.

Regarding claim 5, Applicant disputes Examiner's use of www.PackageNet.com in combination with "Electronic Transfer Associates," "Netcentives," "Microsoft Plaza," and Galler, and again submits that the large number of references relied upon by Examiner suggests that the claimed invention is non-obvious. Examiner reiterates that "Netcentives," "Microsoft Plaza," and Galler all describe the PackageNet system, as, of course, does www.PackageNet.com, weakening the argument that the number of references is excessive, since Examiner is in effect attributing to one of ordinary skill of art at the time of Applicant's invention familiarity with one system described in four references, rather than familiarity with four different systems whose features would have to be combined to reconstruct the claimed invention.

New dependent claims 28-30 do indeed distinguish over the prior art originally used in making the rejections, as Applicant states, but are rejected as obvious based on Hess et al., as set forth above.

Regarding claim 7, Applicant submits that the references, even if combined, would not teach or suggest each and every element of the claimed invention, but does not specify which element or elements is or are not taught. Applicant then argues a lack of motivation or suggestion to urge the combination.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Shkedy provides not merely an element of the claim, but motivation, the rejection being made not for the obvious advantage, but "for the stated advantage, of enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed." Shkedy explicitly teaches the motivation as well as the element (column 8, lines 27-39), and the statement of motivation in the rejection echoes Shkedy's language.

Applicant next argues that Shkedy does not even mention a virtual shopping mall, to which Examiner replies that Applicant may perhaps have overlooked Shkedy's mention of electronic malls (column 1, lines 31-38). Even granting that Shkedy's invention is not directed to a virtual shopping mall (which is debatable, as Shkedy's intermediary could be a mall), it is an unreasonably narrow view to interpret the relevant field of applicant's endeavor solely as virtual shopping malls rather than electronic commerce in more general terms. Applicant provides no reason why the "numerous privacy and competitive reasons" which Shkedy teaches that sellers may have for remaining anonymous, could not apply in a virtual shopping mall.

Regarding claim 14, Applicant argues that Scisco teaches away from the claimed invention, since Scisco describes a seller and his brother building a virtual store. For this argument to have merit, however, claim 14 would have to recite that the seller does not need to build a virtual store, and no such limitation is in fact included. Applicant's

arguments regarding the "large number of references," and the alleged lack of motivation, have already been addressed in regard to other claims. Hess has been added as a reference to reject claim 29, which depends from claim 14.

Regarding claims 15-21, Applicant argues that Knowles is completely unrelated to the claimed invention. Once again, the standard is that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. Knowles does not mention a virtual shopping mall, but is reasonably pertinent to the particular problem with which Applicant was concerned. Knowles is definitely pertinent to Web-based package delivery (Abstract and Figure 10, which is the figure published on the front of the Knowles patent). Anyone selling physical goods through a virtual shopping mall, or other electronic commerce system, would be concerned to some degree with the problem of delivering goods, making prior art such as Knowles pertinent.

With regard to claims 22, 23, and 24, Applicant asserts that Examiner can not take Official Notice of the various things of which Examiner took official notice. This is not quite a proper traversal of official notice, but Examiner has nonetheless responded by making of record prior art to support his takings of official notice, supplying "specific factual findings or concrete evidence."

Claim 25 is largely, although not precisely, parallel to claim 1, although claim 25 recites a recording medium, storing a program, instead of a method, as in claim 1. Once again, Examiner has made of record prior art to support his contention that a

certain practice, in this case, to use recording media storing programs to instruct computers to carry out methods, is well known.

Applicant once again submits that the large number of references relied upon by Examiner suggests that the invention is non-obvious. Examiner responds that the rejection of claim 25 uses only two references, plus official notice, or three references altogether, which is not a very large number, even aside from the doctrine that reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention.

Applicant argues that the cited references are directed to different problems that are completely unrelated to the claimed invention. Examiner replies that the secondary reference, Galler, relates to delivering goods ordered through electronic commerce, which is surely relevant to Applicant's invention, while the primary reference, "Electronic Transfer Associates," explicitly pertains to an electronic mall. The feature of which official notice was taken, using recording media storing programs to instruct computers to carry out methods, pertains to almost anything done by computer, and Applicant does not set forth any grounds for thinking that it does not pertain to the "specialized software" mentioned in the first paragraph of "Electronic Transfer Associates."

Finally, to reiterate, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, the knowledge generally available to one of

ordinary skill in the art of electronic commerce would surely have included that it is necessary to make provision for delivering goods ordered through an electronic shopping mall. Someone who expects physical goods ordered by customers to walk to the customers on their own legs is either selling goods of an unusual type, or lacking in the knowledge that can be expected of anyone possessing ordinary skill in the art. The same might be said of someone who expects a computer to carry out a desired method without a recording medium containing appropriate instructions.

For these reasons, the rejections are held to be correct and proper.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bezos (U.S. Patent 5,727,163) discloses a secure method for communicating credit card data when placing an order on a non-secure network. Suzuki et al. (U.S. Patent 5,946,665) disclose an on-line shopping system using a communication system. Lection et al. (U.S. Patent 5,983,003) disclose an interactive station indicator and user qualifier for virtual worlds. Yagasaki (U.S. Patent 6,125,353) discloses a mall server with product search capacity. Walker et al. (U.S. Patent 6,754,636) disclose purchasing systems and methods wherein a buyer takes possession at a retailer of a product purchased using a communication network.

Chiasson (U.S. Patent Application Publication 2002/0002513) discloses a computer network transaction system. Issa (U.S. Patent Application Publication

2003/0093355) discloses a method, system, and computer site for conducting an online auction.

The anonymous article, "Tools of the Trade" discloses a package for lease inventory management. Keifer ("Service Vendor Alliance Will Simplify Sourcing and Service of Enterprise-Wide Computer Systems") discloses, *inter alia*, a lessor with expertise in leasing computers (paragraph beginning "GE Capital Computer Leasing"). Taj ("ISN Takes Chinese Home Shopping a Step Forward") discloses a Chinese version of the Home Shopping Network, and in particular, inspection of goods by customers to whom they are shipped. Aslett ("Please Re-Lease Me") discloses leasing IT equipment, and managing information through a database system, described as a necessity for those having a large inventory (paragraph beginning "It's a similar story from Peregrine Systems"). Jones ("Pumping up $ales on the Internet") discloses the use of websites and in particular web hosting for electronic commerce. Wood ("Steel Termed Essential Aircraft Component") discloses the use of steel alloys in aircraft, and in particular, inspecting bars and billets prior to shipment (paragraph beginning "Tight chemistry controls"). The anonymous article "Standard & Poor's Approves First Capital International, Inc. For Listing," discloses the listing of First Capital International in Standard & Poor, and in particular discloses EIP Leasing-Estonia as a leasing company involved in equipment leasing. Hickey ("Going Once, Going Twice") discloses auctions on the Web, and in particular, inspection of goods offered for sale on an electronic commerce site (in particular, paragraphs beginning "Unlike TradeOut.com" and "Items are usually listed"). Turner ("Stake out Your Own Little Corner of the Web") discloses

personal and business Web sites, and in particular services offering various amounts of data storage.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
July 8, 2004